

## **IN THE CLAIMS**

**PI as amend the claims as follows:**

1. (PREVIOUSLY AMENDED) A laminable photochromic element comprising a photochromic layer comprising a polyester urethane binder and a photochromic compound, the photochromic layer adhered to one surface of a polymeric layer comprising a polycarbonate resin or a polysulfone resin, wherein the photochromic layer is sandwiched between two polymeric layers, each of the two polymeric layers comprising a polymer selected from the group consisting of polycarbonate and polysulfone resins.

2. (CANCELLED)

3. (PREVIOUSLY AMENDED) The laminable photochromic element of claim 1 consisting of three layers, the photochromic layer and the two sandwiching layers, the two sandwiching layers comprising a polymer selected from the group consisting of polycarbonate resin and polysulfone resin.

4. (CURRENTLY AMENDED) The laminable photochromic element of claim 2 1 fused to a polymeric substrate

5. (CURRENTLY AMENDED) The laminable photochromic element of claim 2 1 adhesively secured to a polymeric surface.

6. (ORIGINAL) The laminable photochromic element of claim 4 wherein the polymeric surface comprises an ophthalmic lens.

7. (ORIGINAL) The laminable photochromic element of claim 5 wherein the polymeric surface comprises an ophthalmic lens.

8. (ORIGINAL) The laminable photochromic element of claim 1 wherein the polymeric layer comprises a polycarbonate resin or a polysulfone resin with a first surface and a second surface, the polyester urethane is contiguous to the first surface of the polymeric layer and to a functional layer selected from the group consisting of scratch resistant layers, anti-fogging layers, tint layers, and hydrophobic layers.

9. (CURRENTLY AMENDED) The laminable photochromic element of claim 2 3 wherein the polymeric layer comprises a polycarbonate resin opr a polysulfone resin with a first surface and a second surface, the polyester urethane is contiguous to the first surface of the polymeric layer and to a functional layer selected from the group consisting of scratch resistant layers, anti-fogging layers, tint layers, and hydrophobic layers.

10. (ORIGINAL) The laminable photochromic element of claim 7 wherein the polymeric layer comprises a polycarbonate resin opr a polysulfone resin with a first surface and a second surface, the polyester urethane is contiguous to the first surface of the polymeric layer and to a functional layer selected from the

group consisting of scratch resistant layers, anti-fogging layers, tint layers, and hydrophobic layers.

11. (CANCELLED)

12. (CANCELLED)

13. (PREVIOUSLY AMENDED) A method of forming a multi-layer polymeric photochromic article comprising securing the laminable photochromic element of claim 1 to a polymeric article.

14. (PREVIOUSLY AMENDED) A method of forming a multi-layer polymeric photochromic article comprising laminating one of said two polymeric layers of the laminable photochromic element of claim 1 to a polymeric article.

15. (PREVIOUSLY AMENDED) A method of forming a multi-layer polymeric photochromic article comprising laminating one of said two polymeric layers of the laminable photochromic element of claim 3 to a polymeric article.

16. (PREVIOUSLY AMENDED) A method of forming a multi-layer polymeric photochromic article comprising laminating one of said two polymeric layers of the laminable photochromic element of claim 4 to a polymeric article.

17. (PREVIOUSLY AMENDED) A method of forming a multi-layer polymeric photochromic article comprising laminating one of said two polymeric layers of the laminable photochromic element of claim 5 to a polymeric article.

18. (CANCELLED)

19. (ORIGINAL) A method of forming a multi-layer polymeric photochromic lens comprising laminating a polymeric layer of the laminable article of claim 7 to a polymeric article.

**Please cancel claims 20-28 as directed to divided, non-elected subject matter.**

20. (CANCELLED)

21. (CANCELLED)

22. (CANCELLED)

23. (CANCELLED)

24. (CANCELLED)

25. (CANCELLED)

26. (CANCELLED)

27. (CANCELLED)

28. (CANCELLED)

## **SUMMARY OF THE REJECTIONS**

### **Rejections Under 35 USC 112, Second Paragraph**

Claims 4-7, 9-10, 17 and 19 have been rejected under 35 U.S.C. 112, second paragraph as the claims depended from a cancelled claim. The above amendment correct that formal issue and remove the rejection.

Claims 8-10 have been rejected under 35 U.S.C. 112, second paragraph because of uncertainty as to which laminate is being claimed. This rejection is respectfully traversed. There is only one construction referred to as a laminate, and that is the composite of all the layers. As there is only a single article completely described in the claim, and as the preamble requires that all following limitations apply to the preamble, there is no lack of clarity in the claims.

Claims 8-10 merely recite that the laminable element of the claims from which they depend are further attached to the functional layer in the manner described. As claim 19 (for example) is clear as to the structure, the attachment of that structure to a single layer is clear on its face, as the layers in contact are specified.

### **Rejection Under 35 USC 103(a)**

Claims 1, 3-10, 13-17 and 19 have been rejected under 35 USC 103(a) as obvious over Bhalakia et al. (U.S. Patent No. 5,757,459) in view of Ormsby et al. (U.S. Patent No. 4,889,413).

Claims 1, 3-10, 13-17 and 199 have been rejected under 35 USC 103(a) as obvious over Bhalakia in view of Rosthauser et al. (U.S. Patent No. 6,107,395).

## **RESPONSE TO THE REJECTIONS**

### **Rejections Under 35 USC 112, Second Paragraph**

All issues have been addressed above by amendment or discussion.

### **Rejection Under 35 USC 103(a)**

Claims 1-10 and 13-19 have been rejected under 35 USC 103(a) as obvious over Bhalakia et al. (U.S. Patent No. 5,757,459) in view of Ormsby et al. (U.S. Patent No. 4,889,413).

Claims 1-10 and 13-19 have been rejected under 35 USC 103(a) as obvious over Bhalakia in view of Rosthauser et al. (U.S. Patent No. 6,107,395).

Both of these rejections suffer from the same defect. Although Bhalakia shows a structure that is laminable to a lens, having a polarizing layer sandwiched between two polymeric layers, that is not suggestive of the presently claimed invention, even with the teachings of the two references. Bhalakia requires the use of the laminate system for applying polarizing layers to the surface of a lens blank prior to molding because the stress on polarizing layers was disruptive of the quality of the polarizing qualities of the layer. As that layer needed to be oriented, it could not be coated onto the outer surface of a lens or lens blank from a solution.

The Bowles reference shows that the art recognized that the problems addressed by Bhalakia were believed to be not needed in the use of photochromic materials. Bowles showed that photochromic layers had already been successfully applied directly to lens after molding by coating of the solution

onto the lens (e.g., spin coating). The problem to be solved by Bhalakia was therefore not seen to exist in the prior art.

Applicants recognized that the use of a laminable sandwich structure with a photochromic intermediate layer solved another, previously unrecognized set of problems. The coating method of Bowles could not consistently provide uniformity or design of the photochromic coating to a molded lens surface. Liquid applied coatings could tend to uncontrolled color variance across the surface of the lens, the desired gradation of density from the middle of the lens to the exterior could not be uniformly controlled, and the application of liquid coatings could not easily be limited to a single surface, so that cleaning or grinding might be needed.

As this problem was not recognized by any of the pairs of references used in the rejection, and as there is no suggestion in any reference of providing laminable photochromic sandwiches, nor of laminating any form of photochromic layers to a lens blank, the art of record fails to teach that the invention as whole is obvious to one skilled in the art. The rejection is in error and should be withdrawn.

### **UNEXPECTED RESULTS**

The rejection has stated that in the absence of any unexpected results, the subject matter is unpatentable over the combination of references. The specification has clearly identified and shown by direct comparisons in the specification (see pages 21-24, especially the Table) that the **polyether urethanes** that are recited in all of the claims show unique and improved

results, even in comparison to polyester urethanes. There is no basis on the record for asserting that these results are obvious to one of ordinary skill in the art from the teachings of either of these combinations of references. As such, even without the clear errors believed to have been shown above, the failure to teach the resulting unexpected properties from the combination system with the polyether urethane renders the rejection insufficient as a matter of law.

The clear showing of unexpected results on pages 21-24 of the specification rebut even a prima facie showing of obviousness, which Applicants assert has not been established on the record.



Authorization is hereby given to charge any additional fees or credit any overpayments that may be deemed necessary to Deposit Account Number 50-1391.

Respectfully submitted,

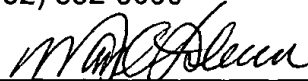
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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Letter is being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on JUNE ~~4~~ 2003.

Mark A. Litman  
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